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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/520,161	03/07/2000	Tadashi Takahashi	862.C1859	9590
5514	7590	04/08/2004	EXAMINER	
FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			TRAN, DOUGLAS Q	
			ART UNIT	PAPER NUMBER
			2624	

DATE MAILED: 04/08/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/520,161

Applicant(s)

TAKAHASHI, TADASHI

Examiner

Douglas Q. Tran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 5-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 5-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 5-9 and 12-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Satoh et al. (US Patent No. 6,327,600) in view of Saito et al. (US Patent No. 6,343,283 B1).

As to claim 5, Satoh discloses a processing method in an apparatus for registering a copyright, comprising the steps of:

receiving a copyright registration request, which is for registering copyright of data, via a network (col. 18, lines 55-60 and col. 19, lines 13-15 shows the application mail would be transmitted to a copyright holder or an agent via the network);

in response to consent to pay the registration fee (i.e., permissible for registration ;col. 6, lines 31-36), embedding an electronic watermark in the data; and transmitting the data having the embedded electronic watermark to the device (col. 4, lines 19-24: the unit 5a has a function for inserting the copyright management information into the document being presently produced at the print device 9 in fig. 1).

However, Satoh does not teach of transmitting a registration fee request to device when issuing the copyright.

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Saito teaches of transmitting a registration fee request to device when issuing the copyright (col. 11, lines 51-53).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the system of Satoh for requesting and collecting fee to the copyright as taught by Saito. The suggestion for modifying the system of Satoh can be reasoned by one of ordinary skill in the art as set forth above by Saito because the modified communication systems allows the processing systems easily to process the paper work during communication between the requesters.

As to claim 6, Satoh and Saito discloses every feature discussed in claim 5, and Satoh further teaches the copyright registration request includes at least one of a term during which copyright protection of the data is desired, data representing monetary compensation regarding the data, and amount of the data (please see fig. 2).

As to claim 7, Satoh and Saito discloses every feature discussed in claim 5, and Satoh further teaches a publication fee applies in a case where the data is published on a web page (col. 19, lines 13-15 indicates the communication via the network would inherently includes the internet communication).

As to claim 8, Satoh and Saito discloses every feature discussed in claim 7, and Satoh further teaches the publication fee is a fixed rate at start of publication and is decided by number of times the data is distributed data after publication (col. 19, lines 22-28 and fig. 2 indicates that the unit 8 checks each time for request by the user related to the pay fee).

As to claim 9, Satoh and Saito disclose every feature discussed in claim 7, and Satoh further teaches the publication fee is a fixed rate at start of publication and is decided by term of

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publication of the data after publication (note: there inherently is the publication fee would be a fixed rate).

As to claim 12, Satoh and Saito disclose every feature discussed in claim 5, and Saito further teaches steps of storing the data having the embedded electronic watermark; in response to receipt of consent, which is in regard to the compensation request, from the device that issued the distribution request, transmitting the data to the device that issued the distribution request (col. 11, lines 51-53).

As to claim 13, Satoh and Saito disclose every feature discussed in claim 12, and Satoh further teaches in response to distribution of the data, generation of compensation conforming to the data is notified to the device that issued the copyright registration request corresponding to the data (col. 19, lines 6-20).

3. Claims 10-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Satoh and Saito, in view of claim 5, and in combination with Ikenoue et al. (US Patent No. 5,671,277).

As to claims 10 and 11, Satoh and Saito disclose every feature discussed in claim 5.

Although Satoh teaches the printed document includes the related information with the copyright article, Satoh does not teach the electronic watermark, which is invisible or nearly invisible to the eye, includes information indicative of a copyrighted article, a code specific to the copyrighted article, and address information of the apparatus which performed the copyright registration.

Ikenoue teaches the electronic watermark, which is invisible or nearly invisible to the eye, includes information indicative of a copyrighted article, a code specific to the copyrighted

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article, and address information of the apparatus which performed the copyright registration (col. 6, lines 7-25, table 1 shows a list of the content of the additional data includes information indicative of a copyrighted article, a code specific to the copyrighted article, and address information of the apparatus which performed the copyright registration; the additional data is embedded onto the hard copy "col. 14, lines 26-30).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the system of Satoh and Saito in order for the hard copy of the document includes the copyright data in the electronic watermark form as taught by Ikenoue. The suggestion for modifying the system of Satoh and Saito can be reasoned by one of ordinary skill in the art as set forth above by Ikenoue because such modification prevents the copying against a copyright.

Response to Arguments and Amendment

4. Applicant's arguments, see page 6, filed 1/23/04, with respect to the rejection of claim 5 under 102 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Saito et al. (US Patent No. 6,343,283 B1). This action is made non-final.

For the above reasons, it is believed that the cited prior art fully discloses the claimed invention and the rejection stand.

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Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Douglas Q. Tran whose telephone number is (703) 305-4857 or E-mail address is Douglas.tran@uspto.gov.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-4700.

Douglas Q. Tran

Apr. 03, 2004

A handwritten signature in cursive script, appearing to read "Tran Douglas", with a long horizontal flourish extending to the left.